

REMARKS

CLAIM REJECTIONS UNDER 35 U.S.C. § 103

The pending claims 21-27 and 29-35 have been rejected under 35 U.S.C. § 103(a) as being unpatentable based upon a single prior art reference, Delot et al. (GB 1546635). Applicant respectfully traverses this rejection since it fails to present a *prima facie* case of obviousness, and accordingly requests reconsideration of the claims.

A. Rejection of Independent Claim 21 is Improper

Independent claim 21 is directed to a device for coating a lengthy product with a melt. Claim 21 requires a tank with the melt and a camera above the tank for receiving melt through a vertical passage. Claim 21 further requires pressure control means for creating pressure discharge in the camera and excessive pressure in the tank whereby the pressure in the tank is maintained greater than the pressure in the camera such that melt will move from the tank upwardly through the vertical passage to the camera.

On page 4 of the Office Action, the Examiner admits that Delot fails to teach the pressure control, the pressure discharge in the camera, and the excess pressure in the tank for transporting the melt from the tank to the camera, as required by claim 21. The Examiner cites no prior art to overcome this deficiency of Delot. Rather, the Examiner states "it is well known in the art at the time of the invention that liquid, specifically molten metal, can be transported by differences in pressure." The Examiner cites no evidence of such knowledge in the art. Thus, the Examiner appears to be taking official notice of the state of the art.

The Examiner's failure to cite any evidence in support of the knowledge of the art, and particularly with regard to pressurized transport of molten metal, does not follow the Patent Office procedures for reliance on common knowledge. In particular, MPEP § 2144.03 states that

rejections based upon "common knowledge" or "well known" prior art should be judiciously applied. § 2144.03(A) emphasizes that

"official notice without documentary evidence to support an Examiner's conclusion is permissible only in some circumstances. . . [and] should only be taken by the Examiner where the facts asserted to be well-known or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-know (citation omitted) . . . the notice of facts beyond the record which may be taken by the Examiner must be 'capable of such instant and unquestionable demonstration as to defy dispute' (citation omitted)."

In other words, facts which can be officially noticed without documentary evidence must be "of notorious character."

In the present application, pressurized transfer of melted coating material from a tank to a camera to coat an elongated product is not of notorious character, and is not instantly and unquestionably well-known. If so, evidence of prior art should be easy to provide.

As § 2144.03(A) further explains,

"It would not (*emphasis in the original*) be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well-known are not capable of instant and unquestionable demonstration as being well-know. For example, assertions of technical facts in the areas of esoteric technology or specific knowledge of the prior art must always be supported by citation to some reference worked recognized as standard in the pertinent art."

This section of the MPEP also cites *In Re Eynde*, 480 F.2d 1364, 1370, 178 U.S.P.Q. 470, 474 (CCPA 1973) wherein the Court of Customs and Patent Appeals expressly rejected the notion that judicial or administrative notice may be taken of the state of the art, since the facts constituting the state of the art are normally subject to the possibility of rational disagreement among reasonable men and are not amenable to taking of such notice.

Furthermore, § 2144.03(A) explains,

"It is never appropriate to rely solely on "common knowledge" in the art without evidentiary support in the record, as the principle evidence upon which a rejection was based."

This section of the MPEP also cites the Federal Circuit case, *In Re Zurko*, 258 F.3d 1379, 1385, 59 U.S.P.Q. 1693, 1697 (Fed. Cir. 2001), wherein the court ruled that the PTO cannot simply reach conclusions based upon its own understanding or experience, or on its assessment of what would be basic knowledge or common sense, but rather, the PTO must point to some concrete evidence in the record in support of these findings. As the *Zurko* court held, "an assessment of basic knowledge and common sense that is not based on any evidence in the record lacks substantial evidence support." Without such substantial evidentiary support, the standard of review applied to findings of fact under the Administrative Procedure Act (APA) is not satisfied.

Applicant is unaware of any prior wherein pressure controls, pressure discharge, and excessive pressure in the camera and tank are provided in accordance with the limitations of claim 21. Therefore, Applicant challenges the Examiner's statement that such pressure controls and relative pressures in the tank and camera are well-known in the art. In essence, the Examiner is relying upon alleged common knowledge as the principle evidence in the § 103 rejection, since the Examiner admits that Delot does not disclose such common knowledge. Without citation of prior art or evidence, such a rejection is improper.

Furthermore, the Examiner's stated application of the allegedly well-known art to the Delot patent defies understanding. More particularly, the Examiner acknowledges that Delot utilizes a pump to move the melt from the tank to the camera, but then asserts that it would be obvious to modify Delot to transport the melt using a pressure differential, with the motivation for the modification being the substitution of a pressure differential in place of the pump for moving molten metal. This is circular reasoning, with the modification and motivation being one

and the same. The Examiner appears to assert that the Delot pump can be eliminated and replaced with some pressure differential, which is otherwise not described. The Examiner goes on to state that "this substitution would be predictable, namely it would essentially provide a pump for transporting the molten metal to the coating camera." In other words, according to the Examiner's logic, the substitution would provide a pump in place of a pump. This makes no sense.

The 2007 *KSR* decision of the Supreme Court emphasized that there must be some rational underpinning for modifying references. 127 US 1727, 1741 (2007). Here, substituting a pump for a pump is not rational.

For all of the above reasons, the § 103 rejection of claim 21 must be withdrawn.

B. The Rejection of Independent Claim 29 is Improper

Independent claim 29 is directed towards a device for coating a lengthy product, and requires a tank with melted coating material, a camera above the tank, and a passage extending between the tank and the camera for supplying coating material from the tank into the camera. Claim 29 further provides that the camera has "a pressure less than atmospheric pressure to prevent leakage of melted coating material through the inlet and outlet."

The Examiner acknowledges on page 6 of the Office Action that Delot fails to teach pressure of the camera less than atmospheric to prevent leakage of coated material through the inlet and outlet of the camera. The Examiner then repeats the assertions regarding the well-known state of the art of transporting molten metal by pressure differentials. This discussion of pressure differentials in the tank and camera for moving the coating material from the tank to the camera appears irrelevant to claim 29, which does not have these limitations of claim 21.

The Examiner further asserts that "it is well-known that pressure differentials can be used to contain materials in given locations which would be expected to retain coating material in the desired area." The Examiner provides no evidence and cites no prior art to support this alleged well-known state of the art. The Examiner then concludes that

"it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Delot's device to include an outlet above the melt level of the camera to release pressure such that the pressure in the camera becomes less than the atmospheric pressure to insure that coated material does not flow through the inlet and outlet. One would have been motivated to make this modification as this would help to ensure that the coating material remained in the camera rather than escaping back to the tank through the inlet and outlet, and also preventing excess coating material from building up upon the product before being completely immersed in the coating material or after being removed from the immersion."

However, Delot utilizes frusto-conical nozzles 19 and 20 to ensure that the coating material does not escape through the inlet or outlet of the camera. In particular, Delot describes the nozzles 19 and 20 as being "molten metal-type sealing nozzles." See page 3, lines 15-19. This sealing function of the nozzles 19 and 20 precludes the coating from escaping from the chamber 5. Furthermore, the conical shape of the nozzles and their relative size compared to the diameter of the article 15 being coated ensures that excess coating material does not build up on the article. Therefore, since the nozzles 19 and 20 of Delot provide the precise functions asserted by the Examiner as being the motivation for modifying Delot, there is no need to make such a modification of Delot as suggested by the Examiner. Again, the Examiner's asserted modification of Delot lacks any rational underpinning, as required by the Supreme Court's *KSR* decision.

Again, the Examiner's apparent attempt to rely upon official notice of the state of the art. However, a pressure differential to contain materials to a desired area is not capable of instant

and unquestionable demonstration, and is not of a notorious character. Therefore, the prerequisites of MPEP § 2144.03(A) for reliance upon well-known prior art without the citation of any evidence or prior art, are not satisfied here.

Accordingly, the § 103 rejection of independent claim 29 should be withdrawn.

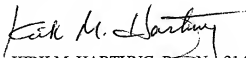
CONCLUSION

In short, the Examiner's apparent reliance upon official notice of the state of the art is hopelessly deficient and fatally defective. The PTO requirements set forth in MPEP § 2144.03(A) have not been satisfied. Therefore, the rejections should be withdrawn and a Notice of Allowance be issued.

No fees are believed to be due in connection with this amendment and application; however, consider this a request for any fees inadvertently omitted, and charge any additional fees to Deposit Account No. 26-0084.

Reconsideration and allowance is respectfully requested.

Respectfully submitted,



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